

**Office Action Summary**

Application No.

10/075,536

Applicant(s)

DIECKROGER ET AL.

Examiner

Que T. Le

Art Unit

2878

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 14-16 is/are allowed.
- 6) ☒ Claim(s) 1-13, 17 and 18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/075,536	02/14/2002	Jens Dieckroger	M&N-IT-242	8479

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LERNER AND GREENBERG, P.A.  
Post Office Box 2480  
Hollywood, FL 33022-2480

EXAMINER

LE, QUE TAN

ART UNIT	PAPER NUMBER
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2878

DATE MAILED: 06/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 2, the phrase "said planar light circuit terminates said optical channel" on lines 1-2 is vague because the manner in which the optical channel being terminated by the circuit has not been clearly defined.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1- 3 are rejected under 35 U.S.C. 102(b) as being anticipated by Hirataka et al (EP 0723171).

Hirataka et al disclose an optical module comprising a planar light circuit having an optical channel (2); a trench (4) formed in the circuit for interrupting the optical channel; and a detection unit (12) disposed in the trench for detecting optical signals in the channel. The detection unit includes a support submount including metal electrodes (6, 7) and solder bumps (8).

Claims 1-8, 10, 11, 17 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Yamamoto et al (EP 0807981).

Yamamoto et al disclose an optical module comprising a planar light circuit having optical channels (13b); a trench (Figures 9-11, 15-17) formed in the planar light circuit for interrupting the optical channels; and a detection unit with photodiodes (PD1, PD2) disposed in the trench for detecting optical signals in the channels. The detection unit is being mounted on a support transparent substrate (1) by solder bumps and electrodes including a common electrode (at least in columns 19-20).

The Yamamoto et al optical module inherently performs the claimed method steps of claims 17 and 18.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9, 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamamoto et al (EP 0807981).

With respect to claim 9, although Yamamoto et al lack a clear inclusion of the use of gold metalizations, the use of gold metalizations or gold electrodes or gold contacts would have been known and being available in the art and selecting gold metalizations or gold electrodes for providing contacts or conductor tracks in an electrical system would have also been obvious to one of ordinary skill in the electrical art. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Yamamoto et al accordingly in order to provide better contacts between the photodiodes and the signal processing of the module.

With respect to claims 12 and 13, although Yamamoto et al fails to specify whether or not the photodiodes are "laser-soldered" on the support submount and whether or not the detection unit is tightly inserted into the trench. These features are considered the manner of forming or installation operation or method of forming the optical module, however, selecting a specific manner for mounting/inserting components/elements into a housing module or system would have been obvious to one of ordinary skill in the art in order to provide a more convenience in installation/replacement of the components of the optical module. It would have been obvious to one of ordinary skill in the art to modify Yamamoto et al accordingly in order to provide a more compact optics design for the optical module.


Claims 14-16 are allowable over the prior art of record because the prior art fails to teach an attenuator apparatus comprising: a multiplicity of optical principal channels carrying optical signals with an optical power respectively passing through an attenuator unit and a respective associated monitor channel receiving a particular percentage of optical power in the principal channel; and a configuration detecting the optical signals in the monitor channels including the above mentioned planar light circuit.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

I) Ohja et al 6,083,843 disclose a method for manufacturing planar lightwave circuits having a plural V-grooves.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Que T. Le whose telephone number is (703) 308-4830.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

  
Que T Le  
Primary Examiner  
Art Unit 2878